Official

FAX RECEIVED
SEP 2 1999
GROUP 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Applicants: Bednorz et al.
Serial No.: 08/303,561
Filed: September 9, 1994
For: NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION TEMPERATURES, METHODS FOR THEIR USE AND PREPARATION

Date: September 2, 1999
Group Art Unit: 1751
Examiner: M. Kopec
Docket No: YO987-074BY

Assistant Commissioner for Patents
Washington, D. C. 20231

I hereby certify that this paper is being facsimile transmitted under Rule CFR 1.61(d) to the U.S. Patent and Trademark Office to (703) 305-7718 on the date shown above.

Daniel P. Morris
Reg. No. 32,053

SUPPLEMENTARY APPEAL BRIEF

OK to ENTER mc

Supplementary Argument To Claim Rejections Under 35 USC 112, First Paragraph

The CCPA held in In re Grice 133 USPQ 365 (1962) in regard to plant patents (and followed this In re Sasse, Beck and Eue, 207 USPQ 107 (1980), in regard to utility patents that:

> the proper test of a description in the publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether

> one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination *be put in possession of the invention on which a patent is sought.* Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentalility under section 102(b). [Emphasis added in In re Sasse, Beck and Eue.]

Since the same languages is used in Section 102(a), the same test applies. In re Sheppard, 144 USPQ 42 (CCPA 1964); Kenmode v. United States, 145 USPQ 658 (CPPA 1965); and DuPont v Ladd, 140 USPQ 297 (DC Cir. 1964). Therefore, the Examiner's rejection of all of Applicants' claims, except for claim 136, under Section 102(a) necessarily means that the Examiner believes that a person of skill in the art is put in possession of applicants claimed invention by the Asahi Shinbum article which refers to Applicants' work and reports the reproduction of Applicants' work in Japan based on Applicants' teaching as described in detail in the Brief. Thus, it is the Examiner's view that all of Applicant's claims are enabled by Applicants' teaching.

In In re Marzocchi, 169 USPQ 367, 370 (1971) the CCPA has said:

> In any event, it is incumbent upon the Patent Office, whenever a rejection on this basis is made [35 USC 112, paragraph 1, enablement], to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

The Examiner has merely stated without extrinsic evidence that the art of high T_c superconductivity is unpredictable. The Examiner points to examples on applicants' specification which do not show high T_c superconductivity which as stated in detail in the Brief are part of Applicants' enabling disclosure.

In In re Wright, 27 USPQ2d 1510, 1513, the CAFC has said:

> Although not explicitly sated in section 112, to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without "undue experimentation".

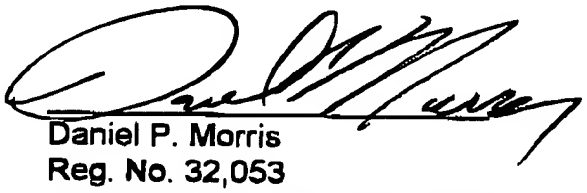
The Examiner has presented no evidence to indicate that "undue experimentation" is required to practice the inventions of Applicants' claims rejected under 35 USC 112, first paragraph. To the contrary, Applicants have submitted substantial evidence showing the processes to make the compositions which are high T_c superconductors were well known prior to applicants filing date and easily practiced. Applicants discovery is that these materials are high T_c superconductors. Thus no "undue experimentation" is necessary to practice Applicants claimed invention. Consequently, the section 112, first paragraph rejections is not only inconsistent with the section 102(a) rejections but is also unfounded and should be reversed.

A patent application is not intended on being a blue print, Staechelin v. Secher 24 USPQ2d 1513, 1516 (BPAI 1992), some experimentation is permitted, Bruning v. Hirose 48 USPQ2d 1934, 1939 (CAFC 1998). "Not every last detail is to be described, else patent specifications would turn into production specifications which they were never intended to be", In re Gay 135 USPQ 316 (CCPA 1962). It is a matter of routine experimentation, based on Applicants' teaching to determine specific examples, other then those specifically described in Applicants' specification, which are within the scope of Applicants' claims.

The Constitutional Policy of the US Patent System is to promote the progress of the useful arts by inducing early disclosure of inventions which Applicants have done by the publication for which they receive the Nobel Prize in 1987. The Examiner's

inconsistent arguments frustrate this policy and the purpose the US Patent Law. The Board is requested to reverse the rejection of Applicants' claims under 35 USC 112, first paragraph.

Respectfully submitted,

By: 

Daniel P. Morris
Reg. No. 32,053
Telephone No.: (914) 945-3217

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598